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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,893	07/11/2003	Phillip J. Bouic	56852US004	4044
32692	7590	08/29/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			MIGGINS, MICHAEL C	
PO BOX 33427			ART UNIT	PAPER NUMBER
ST. PAUL, MN 55133-3427			1772	

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/617,893	BOUIC, PHILLIP J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael C. Miggins	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 January 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 49-60 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-48 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/3/03, 11/3/05</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 49-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/18/05.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 8 recites the limitation "the other edge" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is not clear which edge applicant is referring too, first edge or second edge.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

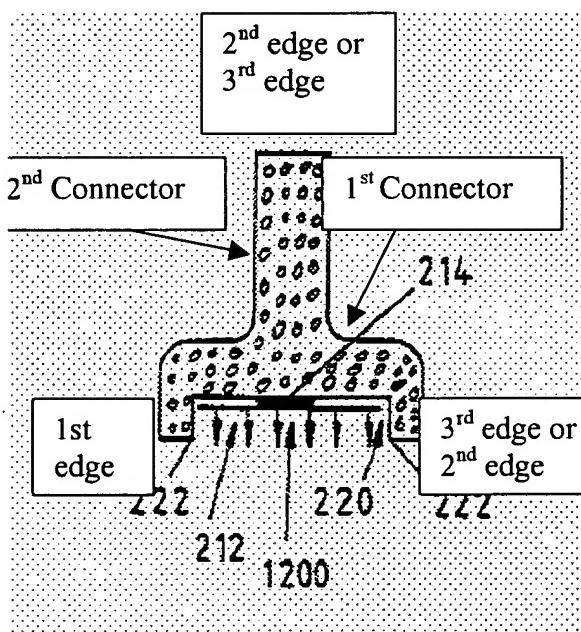
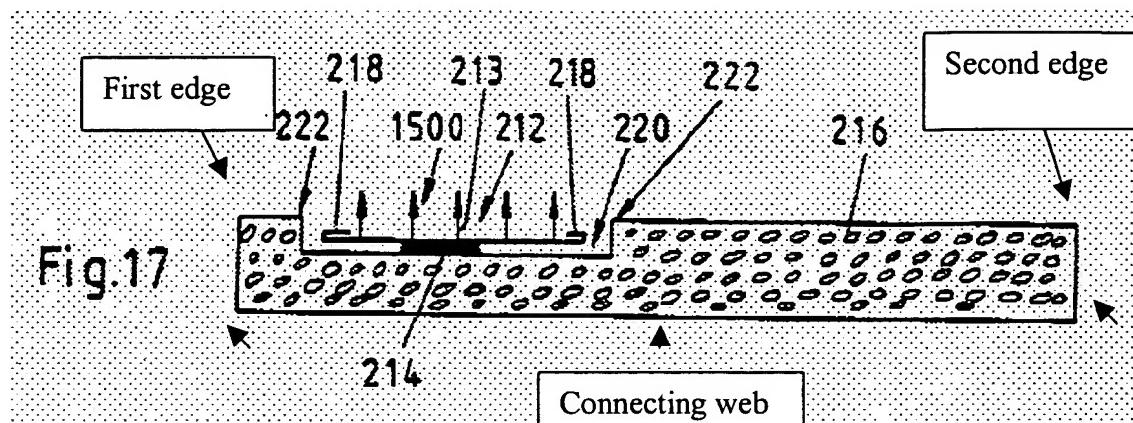
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 7-9, 16-22, 29-30, 32-33, 36, 38, 42-44 and 48 are rejected

under 35 U.S.C. 102(e) as being anticipated by Voß (US 2002/0022158 A1).

Voss discloses an article for use as a masking material to mask a gap between two relatively movable parts (page 1, paragraph [0010] and Fig. 76A) comprising an elongate strip having at least first and second separate edge forming portions for contacting each of the two parts (see Figs. below and Fig. 76A), a flexible web portion connecting each of the two parts, a flexible web portion connecting the first and second edge forming portions for hinging movement such that the first and second edge forming portions can move independently of each other, and adhesive (see Figs. below and Fig. 76A as well as page 11, paragraphs [0250] – [0252]) one side of the connecting web portion for attaching the elongate strip to one of the parts such that said one part is contacted by an adhesive free surface of the first edge forming portion and the other part is contacted by the second edge forming portion (see Figs. below and Fig. 76A) (applies to instant claims 1-2 and 48).



Voss also discloses wherein the article is made of foam (page 1 paragraph [0010]), wherein the connecting web is of reduced thickness relative to at least one, or both, of the first and second edges (see Figs above), wherein the connecting web portion and the other edge are of the same thickness (see Fig. 3A), wherein the second edge forming portions is connected to a third edge forming portion by a second connecting web portion, wherein the second edge forming portion has a larger transverse cross-section than each of the first and

third edge forming portions (see Figs above), wherein each of the first and third edge forming portions have the same or different transverse cross-sections (see second Fig above), wherein the connecting web portion has a width transverse to the length of the strip and is of uniform thickness (see second figure above), wherein the connecting web varies in thickness (see first figure above), wherein the web connecting is smooth (see second figure above) (applies to instant claims 3, 7-9, 16-22).

Voss also discloses wherein the adhesive (214, second figure above) is applied to the connecting web portion as a stripe extending lengthwise of the elongate strip, wherein the sripe is continuous (214, second figure above), wherein the connecting web portion has a width transverse to the length of the strip and the adhesive extends across the full width of the connecting web (644 from 76A and page 11, paragraphs [0250] – [0252]), wherein the adhesive extends partially across the width of the connecting web (see second figure above), wherein the adhesive free surface of said one edge forming portion is provided by an adhesive free region extending lengthwise of the elongate strip (see both figures above), wherein the article comprises a polymer material (since plastic is disclosed (page 1, paragraph [0007]) (applies to instant claims 29-30, 32-33, 36 and 38).

Claims 42-44 in their entirety recite method limitations which do not structurally further limit the product claim 1 from which they depend. Therefore, the prior art need not teach the method limitations to read on applicant's claims

as written since product claims are defined by structure and not the method from which the product is made (MPEP 2113).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4-6, 28, 31 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 2002/0022158 A1) in view Western (US 5885395).

The difference between Voss and the instant claims is that Voss fails to disclose wherein the foam material is an open or closed cell polymeric foam, wherein the foam material is a polyurethane or polyolefin foam, wherein the adhesive is a pressure sensitive adhesive, wherein the stripe is discontinuous, wherein the polymer is an elastomer, a thermoplastic, and wherein the polymer is non-woven.

Western discloses wherein the foam material is an open or closed cell polymeric foam, wherein the foam material is a polyurethane or polyolefin foam, wherein the adhesive is a pressure sensitive adhesive, wherein the stripe is discontinuous, wherein the polymer is an elastomer, a thermoplastic, and wherein the polymer is non-woven (column 2, lines 33-48, column 3, lines 1-12)

in a masking material for the purpose of providing improved masking from paint (applies to instant claims 4-6, 28, 31 and 39-41).

Therefore it would have been obvious to have provided wherein the foam material is an open or closed cell polymeric foam, wherein the foam material is a polyurethane or polyolefin foam, wherein the adhesive is a pressure sensitive adhesive, wherein the stripe is discontinuous, wherein the polymer is an elastomer, a thermoplastic, and wherein the polymer is non-woven in the article of Voss in order to provide improved masking from paint as taught or suggested by Western.

9. Claims 10-15, 21 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 2002/0022158 A1) in view of Jevons (US 6627259).

Voss discloses wherein the connecting web portion is located on a major axis of both edge forming portions, wherein the first and second edge forming portions have the same transverse cross-sections, wherein a single stripe of adhesive is applied to the connecting web portion (see both figures above) (applies to instant claims 11, 14 and 34-35).

The difference between the instant claims and Voss is that Voss fails to disclose wherein first and second edge portions have elliptical transverse cross-section, wherein the connecting web portion is tangential to both edge forming portions, wherein the connecting web portion is located on a major axis of one of the first and second edge forming portions and is tangential to the other edge forming portion, wherein the first and second edge forming portions have

different transverse cross-sections, wherein the connecting web portion has a width transverse to the length of the strip and is of variable thickness across the width, and wherein adhesive is put on at least one of the edge forming portions.

Jevons discloses wherein first and second edge portions have elliptical transverse cross-section (see Fig. 16), wherein the connecting web portion is tangential to both edge forming portions (see Fig. 16), wherein the connecting web portion is located on a major axis of one of the first and second edge forming portions and is tangential to the other edge forming portion (see Fig. 7), wherein the first and second edge forming portions have different transverse cross-sections (see Figs. 5-12 and 16), wherein the connecting web portion has a width transverse to the length of the strip and is of variable thickness across the width (see Figs. 5-6), and wherein adhesive is put on at least one of the edge forming portions (see Figs. 5-12 and 16) in a masking material (column 1, lines 39-47) for the purpose of providing improved masking from paint (applies to instant claims 10-15, 21 and 34-35).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided wherein first and second edge portions have elliptical transverse cross-section, wherein the connecting web portion is tangential to both edge forming portions, wherein the connecting web portion is located on a major axis of one of the first and second edge forming portions and is tangential to the other edge forming portion, wherein the first and second edge forming portions have different transverse cross-sections, wherein the connecting web portion has a width transverse to the

length of the strip and is of variable thickness across the width, and wherein adhesive is put on at least one of the edge forming portions in the article of Voss in order to provide improved masking from paint as taught or suggested by Jevons.

10. Claims 23-27, 37 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 2002/0022158 A1).

Claims 23-27 recite various shapes for the connecting webs. However, a change in shape, in the absence of clear and convincing evidence of unexpected results, is obvious and within the level of one of ordinary skill in the art (MPEP 2144). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the recited shapes for the connecting webs in order to provide improved masking from paint.

Claim 37 recites a value for the length of the adhesive free strip. However, finding the workable or optimum value for a result effective variable, absent clear and convincing evidence of an unexpected result, is obvious and within the level of one of ordinary skill in the art (MPEP 2144). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the recited value in order to provide improved masking from paint.

Claims 45-47 recite obvious engineering design choices and it would have been obvious to one of ordinary skill in the art at the time applicant's invention

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was made to have provided the recited design choices in order to provide improved masking from paint.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is 571-272-1494. The examiner can normally be reached on 1:00-10:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael C. Miggins  
Primary Examiner  
Art Unit 1772



MCM  
April 18, 2005